

Page 14

10/762,615 CCS-101

Remarks

Entry of the above-noted amendments, reconsideration of the application, and allowance of all claims pending are respectfully requested. Following the entry of this amendment, claims 1-30 and 44-47 will be pending. No additional fees for added claims 44-47 are required in view of the fees previously paid for claims now canceled.

Applicant's arguments presented below focus on certain patentable differences between the invention as claimed and the applied references. However, it is not to be inferred that the failure to argue all differences between the claimed subject matter and the applied references constitutes acceptance of assertions made in the Office Action of alleged similarities between elements of the claimed subject matter and the applied references.

Restriction Requirement:

It is confirmed that an election to proceed with claims 1-30 was previously made by telephone conversation. Previously presented claims 31-43, which were withdrawn from consideration in the Office Action in view of the restriction requirement, are canceled without prejudice and are subject to pursuit in a further application. The added claims 44- 47 are consistent with the subject matter of the elected claims and hence are appropriate for consideration.

Claim Rejection - 35 U.S.C. §102:

Claims 1, 4, 10 and 13 were rejected under 35 U.S.C. §102 as being anticipated by Dahod (U.S. Published Application No. 20040224678). This rejection is respectfully traversed for reasons explained below.

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987).

Claim 1

Claim 1 is directed to the method implemented by a push-to-talk wireless mobile terminal. A determination is made if a request to send a delayed delivery voice message has been made. If such a request has been made, an indicator is transmitted from the mobile terminal to a communication application server representing an instruction that packets received from the mobile terminal are to be stored for later delivery to a destination Pal, and that an attempt to set up a substantially real-time voice communication link with the destination Pal is not to be made regardless of whether the destination Pal is or is not currently available to accept a communication from the mobile terminal. Audio input from the user is encoded into packets and the packets transmitted to the communication application server for later delivery to the destination Pal.

This method advantageously provides the user of the push-to-talk wireless mobile terminal with the ability to select a Pal and to leave a voice message for that Pal without causing the wireless infrastructure equipment to attempt to set up a substantially real-time voice communication link with the destination Pal. This eliminates an unnecessary utilization of infrastructure resources and bandwidth as compared with an attempt by the infrastructure equipment to determine whether the mobile utilized by the destination Pal is available for real-time communications. Further, the originating user may have a circumstance due to location or time constraints in which a voice mail message to the Pal is desired, but a real-time communication with the Pal is not desired.

It is clear that Dahod does not provide such a teaching. In fact, Dahod teaches away from the method of claim 1 in that the objective of Dahod is to merely buffer an initial talk spurt by the originating user **concurrent with an attempt to set up a real-time link to the destination terminal** in order to reduce the perceived latency by the originating user. Since the reduction of perceived latency by the originating user is the objective, it is clear that this would not be achieved without the concurrent attempt to set up a real-time communication link to the destination terminal.

It is well-settled that teachings of a reference that teach away from a limitation of the claimed invention must be considered as well as teachings of the reference that could point towards the invention.

...an applicant may rebut a prima facie case of obviousness [or anticipation] by showing that the prior art teaches away from the claimed invention in any material respect. *In re Geisler*, 116 F.3d at 1469, 43 USPQ2d at 1365 (quoting *In re Malagari*, 499 F.2d at 1303, 182 USPQ at 553). *In re Peterson*, 315 F.3d 1325, 65 USPQ2d 1379 (CA FC 2003)
[] added for emphasis.

Hence, Dahod does not anticipate claim 1.

Further, the problem addressed by Dahod is not the same problem addressed by the solution in accordance with claim 1. Therefore, Dahod does not support a 35 U.S.C. 102 rejection of claim 1, and this rejection is requested to be withdrawn.

One of ordinary skill in the art would not have considered combining teachings from other cited prior art into Dahod if such teachings were to negate the basic objective of Dahod, i.e. to reduce the perceived latency by the originating user. This objective requires that an attempt to set up a real-time voice communication channel with the recipient mobile be initiated concurrent with the receipt of the initial talk information from the originator so that the time delay perceived by the originator will be reduced. Therefore, this requirement of Dahod is fundamental to it and any suggested modification of the teachings of Dahod which would eliminate this requirement is not permitted (see *In re Geisler* above). Thus, none of the applied art considered for combination with Dahod would provide a valid basis to support a rejection under 35 U.S.C. 103.

Iyer is cited with regard to the rejection of claims 2, 5-9, 11, 14-18 under 35 U.S.C. 103 in combination with Dahod. In section 3.1 of the Office Action, it is stated that, "Iyer discloses that PTT mobile terminal in which the terminal notifies the user that the receiving terminal is not available and prompt user of the mobile terminal to leave a voice message [paragraph 0051]." Applicant concurs with regard to Iyer determining whether the receiving terminal is available as part of the method; see Iyer, FIG. 5A, 506, 516. Thus, neither Dahod nor Iyer, or the

Page 17

10/762,615 CCS-101

combination thereof, provide a teaching containing the required steps of claim 1.

Mathis is cited with regard to the rejection of claims 3 Ind. 12 under 35 U.S.C. 103. Mathis is cited with regard to a teaching concerning the storing of presence information, e.g. FIG. 2 and 3 of Mathis. Mathis does not teach or suggest the limitations of claim 1 as discussed above. Therefore, neither Mathis or the combination of Mathis with the teaching of the of the references discussed above provide a teaching of the requirements of claim 1.

Eason is cited with regard to the rejection of claims 19-24 under 35 U.S.C. 103 in combination with Dahod and Mathis. Eason is directed to the problem of enabling a sender of a voice mail message to delete that message before it is heard by the intended recipient. Eason is directed towards handling a previously stored voice mail message, not to teachings with regard to the original voice mail storing as required accordance with claim 1. Therefore, neither Eason nor the combination of Eason with the teaching of the other references discussed above provide a teaching of the requirements of claim 1.

Vander Veen is cited with regard to the rejection of claims 25-30 under 35 U.S.C. 103 in combination with Dahod. Vander Veen is concerned with providing an interface between a conventional voice mail system that normally requires audible commands and a graphical user interface that provides a visual display to the user. Audible voice mail system prompts are displayed to the user in a GUI visual format thereby providing an interface between the voice mail system and a display screen utilized by the user. Vander Veen is cited, e.g. see FIG. 8, for disclosing a visual list of messages. Therefore, it is apparent that neither Vander Veen itself nor in combination with the above-described references teach the required steps of claim 1.

None of the above discussed references, considered individually or in combination, provide a teaching or suggestion of the required steps of claim 1. An indication of the allowability of claim 1 is respectfully requested.

Claim 4 and 13

This claim further comprises the step of transmitting a further indicator to the communication application server where the further indicator represents a further instruction to set up a substantially real-time communication link with the destination Pal, where the indicator and the further indicator are different and cause the communication application server to take correspondingly different communication action as to communications for the destination Pal. That is, the originating mobile can request a normal PTT real-time link with the destination Pal (further indicator) or only to store a voice message for the destination Pal where no concurrent real-time link to the Pal is attempted (indicator). The ability to select such alternative types of communications by the originating mobile user on a per communication initiation basis is not taught or suggested by the applied art. Thus, claim 4 should be allowable. For similar reasons, claim 13 should also be allowable.

Claim 10

Independent apparatus claim 10 was rejected on the same grounds as claim 1 and is believed to be allowable for similar reasons discussed above with regard to claim 1.

Claim 19

Independent method claim 19 was rejected under 35 U.S.C. 103 as being on patentable over Dahod in view of Mathis and Eason. This rejection is respectfully traversed.

MPEP §706.02(j) states: "To establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure. In re Vaeck, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991)." Emphasis added.

Claim 19 is directed to a method implemented by a push-to-talk wireless mobile terminal and includes receiving continually updated first data from a communication application server without the mobile terminal having to request same. The first data defines which Pals on a list of Pals of a first user have a corresponding previously transmitted voice message from the first user that is stored and awaits delivery to the corresponding Pal. The displayed list of Pals of the first user includes visual indicia for each Pal representing that a previously transmitted voice message by the first user to at least a first Pal is stored and awaits delivery to the first Pal, where the visual indicia is based on the first data. A determination is made if a request has been made by the first user to access the stored voice message. If such a request was made, the type of access desired by the first user is discerned. A command is transmitted to the communication application server at which the voice message is stored where the command conveys instructions to the communication application server to implement action based on the type of access desired by the first user.

It is acknowledged in the Office Action that Dahod does not teach the claimed displaying step. Mathis is relied upon with regard to the displaying step and is alleged to disclose "PTT mobile terminals configured to display visual icon representing presence status information of the contact list users [Figures 1-4] [0017]". As best seen in FIGs. 2 and 3 of Mathis, a "+" and a "-" are used to indicate available or unavailable terminals for communications. Eason is cited and alleged to teach "the terminal of message sender is configured to request to view pending stored voice messages or request to delete pending stored voice messages intended for receivers". It should be noted that in Eason a request from the user, i.e. the user's communication device, must be initiated to determine status and access previously sent, but not delivered, voice mail messages for each instance where access is desired, e.g. in order to delete an unheard message. That is, continually updated status of all previously sent messages is not available at the user's device in Eason. Eason fails to provide a teaching of the steps of claim 19, e.g. receiving continually updated first data from a communication application server without the mobile terminal having to request same, where the first data defines which Pals on a list of Pals of a first user have a corresponding previously transmitted voice message from the first user that is stored and awaits delivery to the corresponding Pal.

Page 20

10/762,615 CCS-101

Neither Dahod, Mathis, Eason nor the combination thereof teaches a method as required by claim 19 as explained above. Withdrawal of the rejection of claim 19 is requested.

Claim 22

Claim 22 is believed to be allowable for similar reasons explained above for claim 19.

Claims 25 and 28

These claims were rejected under 35 U.S.C. 103 based on Dahod in view of Vander Veen. Claims 25 and 28 are believed to be allowable for similar reasons explained above for claims 19 and 22, respectively. It was acknowledged that Dahod failed to teach the displaying step. Vander Veen merely shows a conventional mail inbox, e.g. FIG. 8, in which a visual indication is provided **only for received messages** with the sender being identified for such messages. This is not equivalent to displaying a listing of Pals and then displaying visual indicia for certain Pals in the list of Pals where each of the certain Pals have a voice message waiting for delivery to the user. Hence neither Dahod nor Vander Veen provides teachings, considered individually or in combination, that render the subject matter of claims 25 and 28 obvious. The withdrawal of the rejection of claims 25 and 28 is requested.

Prohibition of combining prior art teachings

If the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims prima facie obvious. *In re Ratti*, 270 F.2d 810, 123 USPQ 349 (CCPA 1959)

Dahod is directed to a PTT system where walkie-talkie half-duplex communications are used. Any proposed modification of the teaching of Dahod to include elements of a conventional voice mail system or the use of full-duplex telephony techniques would change the principle of

Page 21

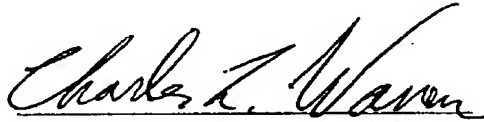
10/762,615 CCS-101

operation of Dahod. Hence, the proposed modifications do not establish prima facie grounds of obviousness for rejections relying on such support.

New claims 44-47 are presented for consideration.

In view of the above amendments and remarks, allowance of all claims pending is respectfully requested. If a telephone conference would be of assistance in advancing the prosecution of this application, the Examiner is invited to call applicants' attorney.

Respectfully submitted,



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